



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

10/783,655

02/20/2004

Jeffrey Yass

192154

7256

7590

09/03/2008

Gregory J. Lavorgna  
Drinker Biddle & Reath LLP  
One Logan Square  
18th & Cherry Streets  
Philadelphia, PA 19103-6996

EXAMINER

SHAIKH, MOHAMMAD Z

ART UNIT

PAPER NUMBER

3696

MAIL DATE

DELIVERY MODE

09/03/2008

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/783,655	<b>Applicant(s)</b> YASS ET AL.	
	<b>Examiner</b> MOHAMMAD Z. SHAIKH	<b>Art Unit</b> 3696	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 14 May 2008.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-42 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-42 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>02/20/04</u> .  | 6) <input type="checkbox"/> Other: _____                          |

### **Detailed Action**

1. This action is made **Non-Final** because examiner is making a new ground of rejection not necessitated by Applicant's amendment.

### **Status of Claims**

2. Claims 1-42 are pending in this application.

### **Claim Amendments**

3. It is noted that claims 1, 18, 30, 37-38 have been amended.

### ***Claim Rejections- 35 U.S.C § 101***

4. Examiner is withdrawing the 35 U.S.C § 101 rejections for claims 1-21 & 37-42.

### ***Claim Rejections- 35 U.S.C § 102***

5. Examiner is withdrawing the 35 U.S.C 102(e) rejection for claims 1-3, 9-13, 16-17, 19-20, 22-23, 32-36, 38-39.
6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 1-6, 10-12, 18-22 are being rejected 35 U.S.C 102(b) as being anticipated by US 2002/0174046 to Mistretta.

Regarding claim 1, Mistretta discloses a system for transacting securities, comprising: a plurality of securities; and a securities combine comprising a computer aggregating the securities in at least one bundled instrument security for transaction ([0010], [0013]).

Regarding claim 2, Mistretta discloses the system as recited in claim 1. Mistretta further discloses wherein the securities comprise any of debt, equity, and hybrid securities ([0011]).

Regarding claim 3, Mistretta discloses the system as recited in claim 1. Mistretta further discloses further comprising bundling rules that instruct the security combine to bundle the securities when creating the bundled instrument security ([0010]).

Regarding claim 4, Mistretta discloses the system as recited in claim 2. Mistretta further discloses wherein the security combine is a trust operated under the guidance of at trustee ([0004], [0075]).

Regarding claim 5, Mistretta discloses system as recited in claim 4. Mistretta further discloses wherein the trustee is a bank ([0075]).

Regarding claim 6, Mistretta discloses the system as recited in claim 4. Mistretta further discloses wherein the bundled instrument security is represented by depositary receipts issued by the trust and administered by the trustee ([0004]).

Claim 10 is being rejected using the same rationale as claim 2.

Regarding claim 11, Mistretta discloses the system as recited in claim 1. Mistretta further discloses wherein the system operates in a computing environment such that the security combine comprises a computing application ([0013]).

Regarding claim 12, Mistretta discloses the system as recited in claim 1. Mistretta further discloses wherein the bundled instrument security is generated from a selected multiple of the plurality of the securities ([0010]).

Regarding claim 18, Mistretta discloses the system as recited in claim 1. Mistretta further discloses wherein receipt from an investor of the bundled instrument security comprises redemption of the bundled instrument security ([0011], [0035]).

Regarding claim 19, Mistretta discloses the system of claim 1. Mistretta further discloses wherein said bundled instrument security comprises a cash distribution is indirectly paid to at least one of the investors ([0034], [0075]).

Regarding claim 20, Mistretta discloses the system as recited in claim 1. Mistretta further discloses comprising a first fee that is charged when creating the bundled instrument security ([0035]).

Regarding claim 21, Mistretta discloses the system of claim 1. Mistretta further discloses a second fee that is charged for the redemption of the bundled instrument security ([0086, [0087], [0088], [0089]]).

Claim 22 is being rejected using the same rationale as claim 1.

Art Unit: 3696

Regarding claim 33, Mistretta discloses the method as recited in claim 22.

Mistretta further discloses wherein said aggregating comprises aggregating a selected number of the plurality of securities to generate the bundled instrument security ([0031]).

Claim 34 is being rejected using the same rationale as claim 34.

Claim 36 is being rejected using the same rationale as claim 20.

Regarding claim 37, Mistretta discloses a system providing a security for transaction, comprising a computer comprising([0013], [0071]): a first means for applying bundling criteria comprising any of security price, market capitalization, trading volume, a listing venue of at least one of a plurality of securities, and investor interest in at least one of a plurality of securities (Fig 6); second means for bundling a plurality of single issuer, uniform typed units of the at least one security into a bundled instrument security in accordance with the bundling criteria ([0031]); third means for selling the bundled instrument security to at least one investor at a price that is a predetermined multiple of at least one unit of the at least one security ([0049]); and fourth means for redeeming the bundled instrument security from at least one investor ([0011], [0035]).

Regarding claim 38, Mistretta discloses a security transaction system, comprising: a plurality of securities ([0031]); and at least one bundled instrument security that comprises a selected multiple of at least one of the plurality of securities ([0010]) ; and a computer programmed to sell-the at least one bundled instrument security to investors ([0049]), and permit investors to redeem the at least one bundled

Art Unit: 3696

instrument security, at a bundle price selected in accordance with a price of at least one of the plurality of securities, and with the predetermined multiple ([0011], [0035]).

8. Claims 7-8,16,23,32 are being rejected over Mistretta in view of U.S Patent 6,615,188 to Breen et al, herein Breen.

Regarding claim 7, Mistretta discloses the system as recited in claim 6. However Mistretta does not disclose wherein the depositary receipts are traded on public securities marketplaces, ECNS, and exchanges. Breen discloses wherein the depositary receipts are traded on public securities marketplaces, ECNS, and exchanges (column 8, lines 9-17). Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to modify Mistretta's invention to include wherein the depositary receipts are traded on public securities marketplaces, ECNS, and exchanges. One of ordinary skill in the art would have been motivated to include wherein the depositary receipts are traded on public securities marketplaces, ECNS, and exchanges in order to ensure that the entire process of bundling the securities operates efficiently.

Regarding claim 8, Mistretta discloses the system as recited in claim 7. However Mistretta does not disclose wherein the depositary receipts are traded as part of a private securities transactions. Breen further discloses wherein the depositary receipts are traded as part of a private securities transactions (column 8, lines 18-24). Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to modify Mistretta's invention to include wherein the depositary receipts are traded as

Art Unit: 3696

part of a private securities transactions. One of ordinary skill in the art would have been motivate to include wherein the depositary receipts are traded as part of a private securities transactions in order to ensure that all pertinent documents are included in the securities transaction.

Regarding claim 9, Mistretta discloses the system as recited in claim 1.

However Mistretta does not disclose wherein the securities are of the same type being issued by a single issuer. Breen discloses wherein the securities are of the same type being issued by a single issuer (column 15, lines 53-55). ). Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to modify Mistretta's invention to include wherein the securities are of the same type being issued by a single issuer. One of ordinary skill in the art would have been motivate to include wherein the securities are of the same type being issued by a single issuer in order to ensure that the single issuer only has to deal with one type of security.

Regarding claim 16, Mistretta discloses the system as recited in claim 1.

However Mistretta does not disclose wherein the bundled instrument security is sold to or redeemed by, investors in according with at least one option position. However Mistretta does not disclose wherein the bundled instrument security is sold to or redeemed by, investors in according with at least one option position. Breen discloses wherein the bundled instrument security is sold to, or redeemed by, investors in accordance with at least one option position (column 81 line 28). Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to modify Mistretta's invention to include wherein the bundled instrument security is sold to or



Art Unit: 3696

redeemed by, investors in according with at least one option position. One of ordinary skill in the art would have been motivated to include wherein the bundled instrument security is sold to or redeemed by, investors in according with at least one option position in order to ensure that all types of investment vehicles are available to investors.

Regarding claim 23, Mistretta discloses the method as recited in claim 22. However Mistretta does not discloses further comprising transacting the bundled instrument security in private or public physical and electronic securities marketplaces. Breen discloses further comprising transacting the bundled instrument security in private or public physical and electronic securities marketplaces (column 8, lines 9-17). Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to modify Mistretta's invention to include comprising transacting the bundled instrument security in private or public physical and electronic securities marketplaces. One of ordinary skill in the art would have been motivated to include comprising transacting the bundled instrument security in private or public physical and electronic securities marketplaces in order to ensure that investors have the option of trading these securities electronically or physically at an exchange.

Claim 32 is being rejected using the same rationale as claim 16.

Art Unit: 3696

9. Claims 13 & 28 are being rejected over Mistretta in view of US 2003/0200164 to Jacobs.

Regarding claim 13, Mistretta discloses the system as recited in claim 12. However Mistretta does not disclose wherein the selected multiple has a value in a selected range in compliance with securities regulations. Jacobs discloses wherein the selected multiple has a value in a selected range in compliance with securities regulations ([0006]). Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to modify Mistretta's invention to include wherein the selected multiple has a value in a selected range in compliance with securities regulations. One of ordinary skill in the art would have been motivated to include wherein the selected multiple has a value in a selected range in compliance with securities regulations in order to ensure that none of the parties is in violation of any laws.

Claims 25-26 are being rejected using the same rationale as claim 12.

Regarding claim 27, Mistretta discloses the method as recited in claim 22. Mistretta further discloses selling the bundled instrument security to at least one investor at a price based on a multiple of at least one of the plurality of the securities ([0049]).

Claim 28 is being rejected using the same rationale as claim 13.

Claim 29 is being rejected using the same rationale as claim 14.

Claim 30 is being rejected using the same rationale as claim 12.

Claim 31 is being rejected using the same rationale as claim 27.

10. Claims 14&15, 24,,29, 37 are being rejected over Mistretta in view of U.S 2002/0087373 to Dickstein et al, herein referred to as Dickstein and further in view of Official Notice.

Regarding claim 14, Mistretta discloses the system as recited in claim 12. However Mistretta does not disclose wherein the selected multiple changes responsive to one or more changes affecting the plurality of securities comprising any of a security split, a reverse security split, and a reorganization event. Dickstein discloses wherein the selected multiple changes responsive to one or more changes affecting the plurality of securities comprising any of a security split, a reverse security split (paragraphs: 0015,0039). Therefore it would have been obvious to one of ordinary skill in the art to modify Mistretta's invention to include selected multiple changes responsive to one or more changes affecting the plurality of securities comprising any of a security split, a reverse security split. One of ordinary skill in the art would have been motivated to include selected multiple changes responsive to one or more changes affecting the plurality of securities comprising any of a security split, a reverse security split in order to ensure that all instruments can be used in the security transaction process. Mistretta does not explicitly disclose reorganization event. Official Notice is taken that a reorganization event is old and well known in the art. Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to modify Mistretta's

Art Unit: 3696

invention to include a reorganization event. One of ordinary skill in the art would have been motivated to include a reorganization event in order to ensure that if different companies merge together that all individuals who own stock are correctly compensated.

Regarding claim 15, Mistretta discloses the system as recited in claim 12.

However Mistretta does not disclose wherein the selected multiple is based on at least one factor comprising any of current share price, market capitalization, trading volume, listing venue, and investor interest. Dickstein discloses wherein the selected multiple is based on at least one factor comprising any of current share price, market capitalization, listing venue, and investor interest (paragraphs: 0018, 0027, and 0047).

Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to modify Mistretta's invention to include wherein the selected multiple is based on at least one factor comprising any of current share price, market capitalization, listing venue, and investor interest. One of ordinary skill in the art would have been motivated to include wherein the selected multiple is based on at least one factor comprising any of current share price, market capitalization, listing venue, and investor interest in order to ensure that the entire security transaction process runs efficiently. Mistretta does not explicitly disclose trading volume. Official Notice is taken that the use of trading volume to determine whether to purchase a security is old and well known in the art. Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to modify Mistretta's invention to include a feature which includes the use of trading volume to determine whether to purchase a security.

Art Unit: 3696

One of ordinary skill in the art would have been motivated to include a feature which includes the use of trading volume to determine whether to purchase a security in order to ensure that investors have all pertinent information available to them before they purchase the security.

Regarding claim 24, Mistretta discloses the method as recited in claim 23. However Mistretta does not disclose further comprising applying bundling criteria comprising any of a security price, market capitalization, trading volume, listing venue of the plurality of the securities and investor interest in the plurality of securities. Dickstein discloses disclose further comprising applying bundling criteria comprising any of a security price, market capitalization, trading volume, listing venue of the plurality of the securities and investor interest in the plurality of securities (paragraphs: 0018, 0027, and 0047). Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to modify Mistretta's invention to include disclose further comprising applying bundling criteria comprising any of a security price, market capitalization, trading volume, listing venue of the plurality of the securities and investor interest in the plurality of securities. One of ordinary skill in the art would have been motivated to include disclose further comprising applying bundling criteria comprising any of a security price, market capitalization, trading volume, listing venue of the plurality of the securities and investor interest in the plurality of securities in order to ensure that the entire security transaction process runs efficiently. Mistretta does not explicitly disclose trading volume. Official Notice is taken that the use of trading volume to determine whether to purchase a security is old and well known in the art. Therefore

Art Unit: 3696

it would have been obvious to one of ordinary skill in the art at the time of the invention to modify Mistretta's invention to include a feature which includes the use of trading volume to determine whether to purchase a security. One of ordinary skill in the art would have been motivated to include a feature which includes the use of trading volume to determine whether to purchase a security in order to ensure that investors have all pertinent information available to them before they purchase the security.

Regarding claim 29, Mistretta discloses the method as recited in claim 27.

However Mistretta does not disclose further comprising changing the multiple responsive to one or more events surrounding the plurality of securities comprising any of: a security split, a reverse-security-split, a reorganization event, mandatory redemption, and mandatory conversion. Dickstein discloses further comprising changing the multiple responsive to one or more events surrounding the plurality of securities comprising any of: a security split, a reverse-security-split (paragraphs: 0015, 0039).

Therefore it would have been obvious to one of ordinary skill in the art to modify Mistretta's invention to include further comprising changing the multiple responsive to one or more events surrounding the plurality of securities comprising any of: a security split, a reverse-security-split. One of ordinary skill in the art would have been motivated to include further comprising changing the multiple responsive to one or more events surrounding the plurality of securities comprising any of: a security split, a reverse-security-split in order to ensure that all instruments can be used in the security transaction process. Mistretta does not explicitly disclose reorganization events a mandatory redemption and conversion. Official Notice is taken that a reorganization

Art Unit: 3696

event is old and well known in the art. Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to modify Mistretta's invention to include a reorganization event. One of ordinary skill in the art would have been motivated to include a reorganization event in order to ensure that if different companies merge together that all individuals who own stock are correctly compensated. Official Notice is taken that mandatory conversion and redemption are old and well known in the art. Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to modify Mistretta's invention to include mandatory conversion and redemption. One of ordinary skill in the art would have been motivated to include mandatory conversion and redemption in order to ensure the all outstanding securities are converted to a particular financial instrument.

11. Claim 17 is being rejected under 35 U.S.C 103(a) as being unpatentable over Mistretta in view of US 2002/0099645 to Agarwal et al, herein Agarwal.

Regarding claim 17, Mistretta discloses the system as recited in claim 1. However Mistretta does not disclose wherein a dollar value spread is tighter in the bundled instrument security than in the ones of the plurality of securities. Agarwal discloses wherein a dollar value spread is tighter in the bundled instrument security than in the ones of the plurality of securities ([0127], [0128], [0129]). Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to modify Mistretta's invention to include wherein a dollar value spread is tighter in the bundled instrument security than in the ones of the plurality of securities. One of ordinary skill in the art would have been motivated to include wherein a dollar value spread is tighter in

Art Unit: 3696

the bundled instrument security than in the ones of the plurality of securities in order to ensure that the investor obtains the optimum price of the securities.

12. Claim 35 is being rejected under 35 U.S.C 103(a) as being unpatentable over Mistretta in view of US 2005/0119962 to Bowen et al, herein Bowen.

Regarding claim 35, Mistretta discloses the method as recited in claim 34. However Mistretta does not disclose listing the tradable receipts on an exchange comprising any of a national securities exchange, ECNs, and NASDAQ. Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to modify Mistretta's invention to include listing the tradable receipts on an exchange comprising any of a national securities exchange, ECNs, and NASDAQ. One of ordinary skill in the art would have been motivated to include listing the tradable receipts on an exchange comprising any of a national securities exchange, ECNs, and NASDAQ in order to ensure that the investor has access to all trading platforms.

13. Claim 40 is being rejected over Mistretta in view of Dickstein and further in view of U.S 2003/0069817 to Graff.

Regarding claim 40, Mistretta discloses the security transaction system of claim 39. However Mistretta does not disclose wherein the equity securities are selected from the group consisting of common stock, preferred stock, convertible or exchangeable preferred and preference stock, warrants, options, American Depositary Receipts, and interests in limited partnerships and limited liability companies. Dickstein discloses wherein the equity securities are selected from the group consisting of common stock,



Art Unit: 3696

preferred stock, convertible or exchangeable preferred and preference stock, warrants, options (paragraph 0027). Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to modify Mistretta's invention to include wherein the equity securities are selected from the group consisting of common stock, preferred stock, convertible or exchangeable preferred and preference stock, warrants, options.

One of ordinary skill in the art would have been motivated to include wherein the equity securities are selected from the group consisting of common stock, preferred stock, convertible or exchangeable preferred and preference stock, warrants, options in order to ensure that all different types of securities can be used in the transaction system.

Graff discloses American Depositary Receipts, and interests in limited partnerships and limited liability companies (paragraphs 0020, 00053). Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to modify Mistretta's invention to include American Depositary Receipts, and interests in limited partnerships and limited liability companies. One of ordinary skill in the art would have been motivated to include American Depositary Receipts and interests in limited partnerships and limited liability companies in order to ensure that the equity securities encompass all types of instruments.

14. Claim 41 is being rejected over Mistretta in view of Dickstein and Graff and further in view of Official Notice.

Regarding claim 41, Mistretta discloses the security transaction of claim 39. However Mistretta does not disclose wherein the debt securities comprise any

Art Unit: 3696

of unsecured notes and debentures, secured notes, mortgage bonds, collateral trust bonds, convertible and exchangeable bonds, notes and debentures. Dickstein discloses unsecured notes, secured notes, and notes (paragraph 0027). Therefore it would have been obvious to one of ordinary skill in the art to modify Mistretta's invention to include unsecured notes, secured notes, and notes. One of ordinary skill in the art would have been motivated to include unsecured notes, secured notes, and notes in order to ensure that all types of instruments are included. Graff discloses mortgage bonds, debentures (paragraph 0121, 0131). Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to modify Mistretta's invention to include mortgage bonds and debentures. One of ordinary skill in the art would have been motivated to include mortgage bonds and debentures in order to ensure that all different types of debt securities are included. Breen does not explicitly teach collateral trust bonds, and convertible and exchange bonds. Official Notice is taken that collateral trust bonds, and convertible and exchange bonds are old and well known in the art. Therefore it would have been obvious to one of ordinary skill in the art to modify Mistretta's invention to include collateral trust bonds, and convertible and exchange bonds. One of ordinary skill in the art would have been motivated to include collateral trust bonds and convertible and exchange bonds in order to ensure that all types of equity securities are included in the security transaction process.

15. Claim 42 is being rejected under 35 U.S.C 103(a) as being unpatentable over Mistretta in view of Dickstein.

Art Unit: 3696

Regarding claim 42, Mistretta discloses the security transaction system of claim 39. However Mistretta's does not disclose wherein the hybrid securities comprise convertible notes. Dickstein discloses wherein the hybrid securities comprise convertible notes (paragraph 0027). Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to modify Mistretta's invention to include wherein the hybrid securities comprise convertible notes. One of ordinary skill in the art would have been motivated to include wherein the hybrid securities comprise convertible notes in order to ensure that all types of securities are available to the investor.

***Response to Remarks***

16. Applicant's arguments, filed on 05/14/08 with respect to the rejections of claim(s) 1-3,9-13,16-17,19-20,22-23,25-28,32-36,38-39 under 35 U.S.C 102(e) have been fully considered and are persuasive. Therefore the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of US 2002/0174046 to Mistretta in view of U.S Patent 6,615,188 to Breen et al, and US 2003/0200164 to Jacobs and U.S 2002/0087373 to Dickstein and US 2002/0099645 to Agarwal and US 2005/0119962 to Bowen and further in view of U.S 2003/0069817 to Graff.

## **CONCLUSION**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MOHAMMAD Z. SHAIKH whose telephone number is (571)270-3444. The examiner can normally be reached on Monday-Friday (7:30-5); alt Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tom Dixon can be reached on 571-272-6803. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/M. Z. S./  
Examiner, Art Unit 3696

Mohammad Z Shaikh  
Examiner  
Art Unit 3696

**/Daniel S Felten/**

**Primary Examiner, Art Unit 3696**

Application/Control Number: 10/783,655  
Art Unit: 3696

Page 21